

REMARKS

Claims 12 to 17 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for indicating that claims 16 and 17 contain allowable subject matter. Accordingly, claim 12 has been rewritten to include the features of claim 16, which has been canceled without prejudice, and claim 17 has been rewritten to include the features of claim 12. Accordingly, claim 12 is allowable, as are its dependent claims 13 to 15, and claim 17 is allowable. It is therefore respectfully requested that the objections be withdrawn.

As to page two (2) of the Final Office Action, claims 12 to 15 were rejected under 35 U.S.C. § 102(b) as anticipated by Lyons et al., U.S. Patent No. 5,826,216.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 12 has been rewritten to include the features of claim 16, which has been canceled without prejudice, and claim 17 has been rewritten to include the features of claim 12. Accordingly, claim 12 is allowable, as are its dependent claims 13 to 15, and claim 17 is allowable. It is therefore respectfully requested that the rejections be withdrawn.

In sum, claims 12 to 15 and 17 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims 12 to 15 and 17 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: _____

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By: _____

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